



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,282	11/26/2003	Thomas Wien	11286-01250	1147

7590 12/23/2005

Douglas N. Larson
Squire, Sanders & Dempsey, L.L.P.
14th Floor
801 S. Figueroa Street
Los Angeles, CA 90017

EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
----------	--------------

1734

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,282

Applicant(s)

WIEN ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 Sept 2005 & 23 Sept 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 250-255, 258-262, 271, 273-282, 297-301, 362 and 375-381 is/are allowed.
- 6) ☒ Claim(s) 231-244, 246-249, 257, 263-270, 283-294, 296, 303-344, 350-362 and 365-375 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims:

Claims pending in the application are 231-244,246-255,257-271,273-294,296-301,303-344,350-362 and 365-381.

DETAILED ACTION

Response to Amendment

1. Applicant is reminded that when amending the claims they must properly disclose where support for the proposed amendment comes from. In particular, applicant needs point to specific parts of specification which discuss these features. This is required by MPEP §714.02 and §2163.06. See 37 CFR 1.111.

Response to Arguments

2. With respect to the § 112 rejections set forth in the last Office Action, in applicant's First Response dated 13 September 2005 (hereafter "First Response"), applicant refers to a couple of paragraphs and some figures on pages 27 and 28 of the response, but fails to answer all the rejections set forth by the examiner. Listing examples of features does not amount to a response to very specific rejections, as there is now way for the examiner to determine which "example" goes with which rejection. In writing the rejection, a great deal of time was spent going through the specification and drawings. The examiner relied on the claim language to look for the details in the specification, but the applicant either is using different terms in the specification than in the claims or the features described in the § 112 rejections below are not the specification. Applicant implies on page 27 of the First Response that the examiner did not consult the drawings before making this rejection. This is simply not the case. There are 35 pages to the specification and 45 pages of drawings containing 123 Figures, not to mention 138 pending claims. It is requested applicant respond completely to the § 112 rejections still remaining and point out where support for the claimed features exist whether those features be in the drawings or specification and if

Art Unit: 1734

the features are in the drawings please point to a corresponding numeral which points to the claimed feature.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 235, 236, 248, 249, 257, 263-270, 292-294, 296, 365, 373, and 374 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Regarding claims 235 and 236, the examiner was unable to find support for "second circle" or " first circle" in the original specification. The only use of the word circle in the specification is in relation to Figures 116 & 118 and these do not seem to apply to these claims.

Regarding claims 248, 249, and 365¹, applicant again presents the "second label having a wide central opening" and claims it in such a manner as to imply their distinct application positions. The examiner was unable to locate support for this claim and/or feature in the original specification.

Regarding claims 257 and 373², the claims present "rims" on the support surface, there appears to be no support for this feature in the original specification.

¹ It is noted in Applicant's First Response, claim 365 replaced claim 295 which was rejected previously under Sect. 112 and the rejection was not addressed in applicant's response.

² It is noted in Applicant's First Response 05, claim 363 replaced claim 256 which was rejected previously under Sect. 112 and the rejection was not addressed in applicant's response. In Applicant's Second Response dated 23 September 2005 (hereafter "Second Response"), applicant replaced claim 363 with claim 373.

Art Unit: 1734

Regarding claims 263-270 and 296, there is no discussion in the specification of a second label position as set forth in these claims which is distinct from the first labeling position.

Regarding claim 374, this claim depends from claim 373.

Considering the size of the specification (35 pages) and the fact that there are 45 pages of drawings and 123 Figures, the examiner again requests a clear indication where the support comes from for each of these claims, if such support exists. The rejection was made because the examiner could not locate the support on her own using the language the applicant used in the claims.

5. Claims 283-290 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant has again failed to give an explanation of where the support for the "locator assembly" and "lift post" as set forth in claims 283 through 290 comes from. While the subject matter of the specification is not complicated, the size of the specification and varying embodiments that the applicant presents makes the application complex, especially considering there over 130 pending claims. Assistance in locating the support for the claims, particular Figures and numbers on those figures, is appreciated. In the remarks dated 01 December 2004, applicant merely states "[c]laim 283 is disclosed by post assembly 404, locator member 420, lift post 404, etc. Additionally, it is disclosed by post assembly 120, applicator body 104, locator assembly 320, 324, etc." These references numbers are in a variety of Figures and located in a variety of locations throughout the specification. Furthermore, this suggests that the post assembly and the lift post, both

Art Unit: 1734

reference number 404, are the same portion of the applicator defined in claim 283.

Clarification is required. In the response dated 13 September 2005, applicant lists examples of where certain things are but does not point out how these examples relate to the rejected claims. The examiner cannot hope to interpret such a vague response considering there are over 123 Figures with numerous embodiments disclosed in those figures.

Considering the size of the specification (35 pages) and the fact that there are 45 pages of drawings and 123 Figures, the examiner again requests a clear indication where the support comes from for each of these claims, if such support exists.

6. Claims 303-314 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant states this claim contains the same features of claim 283, but has failed to point out support for claim 283. Please show where there is support for the label applicator as defined in claims 303-314. Figure numbers and reference to the features in the Figure is appreciated.

Considering the size of the specification (35 pages) and the fact that there are 45 pages of drawings and 123 Figures, the examiner again requests a clear indication where the support comes from for each of these claims, if such support exists.

7. Claims 315-326, 335, 344, and 372 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 315-326, 335, 344, and 372 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant claims

Art Unit: 1734

"label centering ring, a centering post, and a spindle extending up from a top surface of the centering post" and requires "the centering ring being movable in an opening in a center of the support surface and being concentric with the centering post." The applicant failed to point out where support for this "label centering ring" occurs in the specification. Please point out a Figure, including numerals, and a portion of the specification which shows this "label centering ring" and how the "label centering ring" is different than the centering post and the spindle also set forth in claim 315.

Considering the size of the specification (35 pages) and the fact that there are 45 pages of drawings and 123 Figures, the examiner again requests a clear indication where the support comes from for each of these claims, if such support exists.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 235, 236, 257, and 366-371 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 235 and 236, applicant presents "a second circle" in claims 235 and a "first circle" in claim 236, it is unclear from the specification what this first and second circle are and where it is located.

11. Claim 257 recites the limitation "the first and second rims" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 366 recites the limitation "the centering ring" in line 5. There is insufficient antecedent basis for this limitation in the claim. Claim 327 from which claim 366 depends discloses "an outer centering ring." Appropriate correction, clarification is required.

Art Unit: 1734

Claim Objections

13. Claim 257 is objected to because of the following informalities: It depends from cancelled claim 256. Appropriate correction is required.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 231, 232, 242-244, 248, 249, and 291-294 are rejected under 35 U.S.C. 102(b) as being anticipate by Hummell (US Patent No. 5,951,819).

Regarding claim 231, Hummell presents a label applicator including an applicator body (20) including a label support surface (21, 22); a post assembly (30, 35) extending up from a central area of the label support surface; the post assembly (30, 35) having a first effective diameter adapted to center a label (22) having a central opening in a label application position on the support surface with an adhesive face of the label disposed upwardly; engagement structure (28) positionable by a user between an operative position and an inoperative position, the engagement structure (28) when in the operative position extending generally above the label support surface and capable of being in an inoperative position when the first label is in the first application position; and the post assembly (30,

Art Unit: 1734

35) including an article support surface (38) adapted to support an article in a position such that the article can be pressed down and against the adhesive face of label.³ (See Figures 1, 3, and 4.)

Regarding claim 232, the label support surface in Hummell includes a foam element (22) which results in that surface being generally above the engagement structure (28) when is in its "inoperative" position. (See Figure 4.)

Regarding claims 242-244, the device of Hummell is capable of handling a CD, DVD, or disc.

Regarding claim 248, Hummell presents a label applicator including an applicator body (20) including a label support surface (21, 22); a post means (30, 35) extending up from a central area of the label support surface; centering means (28) positionable by a user between an operative position and an inoperative position, the centering means (28) when in the operative position extending generally above the label support surface; and the post means (30, 35) centering the label and including an article support surface (38) adapted to support an article in a position such that the article can be pressed down and against the adhesive face of label.⁴ (See Figures 1, 3, and 4.)

Regarding claim 249, the centering means (28) extends below the label support when in an "operative" position.

Regarding claim 291, the post assembly in Hummell is capable of centering the label when the engagement structure is in an inoperative position.

Regarding claim 292, the centering means (28) outer surface is capable of engaging the opening of the label for aligning the label onto the applicator.

³ Applicant is reminded that an examiner has a responsibility to give a claim its "broadest reasonably interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Furthermore, "[w]hile features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Art Unit: 1734

Regarding claim 293, again the post means (30, 35) engages the label for aligning it onto the applicator.

Regarding claim 294, the centering means (28) moves relative to the label support surface.

16. Claims 231 and 241 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwaller (US Patent No. 6,508,914 B1).

Regarding claim 231, Schwaller presents a label applicator including an applicator body (2) including a label support surface (2B); a post assembly (4) extending up from a central area of the label support surface; the post assembly (4) having a diameter adapted to center a label (12e) having a central opening in a label application position on the support surface with an adhesive face of the label disposed upwardly; engagement structure (3) positionable by a user between an operative position and an inoperative position, the engagement structure (3) when in the operative position extending generally above the label support surface; and the post assembly (4) including an article support surface (4f) adapted to support an article in a position such that the article can be pressed down and against the adhesive face of label. (See Figures 1 and 2B.)

Regarding claim 241, the article support surface (4f) includes a plurality of outwardly-extending surfaces (4a).

17. Claims 231-234, 237-240, 242-244, 291, 327-334, 336-343, and 351-361 are rejected under 35 U.S.C. 102(e) as being anticipated by Hummell et al. '113 (US Patent No. 6,660,113 B2).

Regarding claim 231, Hummell '113 presents a label applicator including an applicator body (20) including a label support surface (24); a post assembly (30, 32) extending up from a central area of the label support surface; the post assembly (30, 32)

⁴ The applicant did not define a structural feature which would distinguish their claim from the prior art of Hummell, thus applicant's discussion of applying a second label does not distinguish their structure from the prior

Art Unit: 1734

having a first effective diameter adapted to center a label (12) having a central opening in a label application position on the support surface with an adhesive face of the label disposed upwardly; engagement structure (36, 38) positionable by a user between an operative position and an inoperative position, the engagement structure (36, 38) when in the operative position extending generally above the label support surface; and the post assembly (30, 32) including an article support surface (92) adapted to support an article in a position such that the article can be pressed down and against the adhesive face of label. (See Figure 1.)

Regarding claim 232, the "inoperative" position is below the label support surface as seen in Figure 4.

Regarding claims 233 and 234, the engagement structure in Hummell '113 includes a plurality of posts (36, 38) which are movable as detailed above.

Regarding claim 237, the engagement structure of Hummell '113 (36, 38) is disposed radially outward from the post assembly. (See Figure 1.)

Regarding claim 238, the post assembly (30) is movable relative to the support surface. (See Figures 1 and 4.)

Regarding claim 239, the size of the central openings of the label does not further limit the apparatus claim 231.⁵

Regarding claims 240 and 246, the article support (92) in Hummell '113 is a ridge or ledge.

Regarding claims 242-244, the device of Hummell '113 is capable of handling a CD, DVD, or disc.

Regarding claim 247, the engagement structure in Hummell '113 has a portion (36, 38, 40) which extends below the label support surface (24) when in an operative position.

art structure.

Art Unit: 1734

Regarding claim 291, the post assembly in Hummell '113 is capable of centering the label when the engagement structure is in an inoperative position.

Regarding claim 327, Hummell '113 discloses a label applicator including a label support surface (24); a label application post assembly (30) at a central area of the support surface; the post assembly including an outer centering ring (36, 38) movable in an opening in the support surface; the post assembly further including a centering post (32) and a spindle (66) fixed to the centering post and extending up from a top surface thereof, the outer centering ring being concentric with the centering post; and a support ledge defined by the top surface of the centering post. Hummell includes a coil spring (94). (See Figures 1 and 2.)

Regarding claim 328, the centering ring (36, 38) is biased with a spring (94).

Regarding claim 329, the centering post (30) has a first effective diameter and the centering ring (36, 38) has a second effective diameter. The language of the claim discussing first and second label application amounts to functional language and fails to limit the structure of the label applicator of the claim.⁶

Regarding claim 330, the centering post (30) is adapted to center a label in a raised position.

Regarding claim 331, the centering ring (36,38) is capable of centering a second label as required by the claim.⁷

Regarding claims 332 and 333, the centering post (30) includes an article support ledge (92) which is adapted to support an optical disc whether for application to a second label or a first label.⁸

⁵ "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935).

⁶ While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Art Unit: 1734

Regarding claim 334, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). Applicant's giving size to the openings of the labels (which are material worked upon) does not impart patentability to the apparatus claims.⁹ Furthermore, one of ordinary skill would know to make the applicator capable of handling the label, thus appreciate the size of the label's opening must be known and foreseeable.

Regarding claim 336, the limitations are sufficiently set forth above.

Regarding claim 337, the centering ring (36, 38) is biased with a spring (94).

Regarding claim 338, the centering post (30) has a first effective diameter and the centering ring (36, 38) has a second effective diameter. The language of the claim discussing first and second label application amounts to functional language and fails to limit the structure of the label applicator of the claim.

Regarding claim 339, the centering post (30) is adapted to center a label in a raised position.

Regarding claim 340, the centering ring (36,38) is capable of centering a second label as required by the claim.

Regarding claims 341 and 342, the centering post (30) includes an article support ledge (92) which is adapted to support an optical disc whether for application to a second label or a first label.

⁷ A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

⁸ "[A]pparatus claims cover what a device *is*, not what a device *does*." (emphasis in original) *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) .

⁹ See MPEP §2115.

Art Unit: 1734

Regarding claim 343, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). Applicant's giving size to the openings of the labels (which are material worked upon) does not impart patentability to the apparatus claims. Furthermore, one of ordinary skill would know to make the applicator capable of handling the label, thus appreciate the size of the label's opening must be known and foreseeable.

Regarding claim 351, the limitations are set forth above. The centering ring (36, 38) is movable in an opening in a central area of the support surface. As can be seen in Figure 7, the central area with respect to the base (20).¹⁰

Regarding claim 352, fails to further limit claim 351 structurally. The device of Hummell is capable of performing the functional steps.

Regarding claim 353, the centering post (30) centers the label.

Regarding claim 354, the centering ring (38, 39) is adapted to center a label.

Regarding claims 355 and 356, the spindle extends and the top surface defines a support. The support is for truncated disc but would also be capable of handling a small round disc.

Regarding claim 357, the spindle is upwardly biased on the post (30).

Regarding claim 358, the post (30) is biased with a spring (94).

Regarding claims 359 and 360, the centering ring (38, 39) is movable and a portion is located below the support surface (24).

Regarding claim 361, the centering ring (36, 38) is biased with a spring (94).

¹⁰ "Central area" is defined by the examiner as being central with respect to the length-wise portion of the support surface. Applicant's claim is very general and allows for a broad interpretation.

Allowable Subject Matter

18. Claims 250-255, 258-262, 271, 273-282, 297-301, 362, and 375-381 are allowed.

Response to Arguments

19. Applicant's arguments filed 13 September 2005 & 23 September 2005 have been fully considered but they are not persuasive.

20. As addressed above, the response to the § 112 rejections is insufficient to overcome the rejections thus they are presented again above. There is no doubt that drawings alone can provide support for the claims, but upon review of the drawings, the examiner was not able to find the support for the claimed invention. If applicant would point to the particular drawing and numeral that provides support for each of the rejected claims above, it would be most appreciated. The mere examples applicant lists on pages 27 and 28 of the First Response of the support without specifically pointing to the claim applicant is showing support for is not sufficient.

21. On page 28 of the First Response, applicant suggests the examiner has taken the position that the descriptive phrase "adapted to" is not a structural limitation. It is unclear how the applicant has come to this conclusion, as this was never explicitly stated in the Office Action. It is the position of the examiner that none of the structural limitations have been "ignored." Additionally, applicant has failed to point out any specific instances where the examiner has not considered a claimed structure.

22. In response to applicant's argument that Hummell '819, Hummell '313, and Schwaller teach the applicators have operative and unoperative positions, this is simply not the case. First, as set forth above the examiner could find no discussion of first and second labels. Additionally, when the engagement structure in Hummell '819 (represented by

Art Unit: 1734

numeral 28) moves up and down as shown in Figures 3 and 4, it moves between operative and unoperative positions. The same is true with Hummell '313 and Schwaller as detailed above.

23. At the bottom of page 28 of the First Response, applicant points to paragraphs 133 and 142 of the specification. It is possible applicant is attempting to address the § 112 rejections here, but that is unclear. However, it is noted by the examiner that these paragraphs do not define any structure in the disclosed label applicators which makes them different from the prior art cited. The prior art references are capable of handling labels with varying sized inner holes.

24. In general, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Also, applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Furthermore, applicant fails to show how the amendments avoid such references or rejections.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

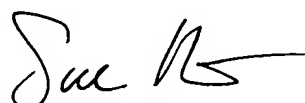
Art Unit: 1734

after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
December 20, 2005